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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,654	12/21/2000	Michael Hannington	AVERP2850US	7505
7590	10/05/2004			
Heidi A. Boehlefeld Renner, Otto, Boisselle & Sklar, L.L.P. 19th Floor 1621 Euclid Avenue Cleveland, OH 44115			EXAMINER CHANG, VICTOR S	
			ART UNIT 1771	PAPER NUMBER
DATE MAILED: 10/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,654

Applicant(s)

HANNINGTON, MICHAEL

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-29 and 32-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-29 and 32-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicant's amendment to the specification and remarks filed on 9/2/2004.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, in respect to the suitable thickness of the non-adhesive material, Applicant's argument "Although claim 27 is broad, it is fully enabled, and thus need not be narrowed" (Remarks, page 7, bottom paragraph) is persuasive, as such the suggestion to incorporate claim 28 into claim 27 is withdrawn.

Claim Objections

4. Claim 28 is objected to because of the following informalities:

The Examiner repeats (see section 4 of Office action dated 6/10/2004) that in claim 28, line 2, please correct the recitation "30 nanometers" to "--300 nanometers", so as to be consistent with the teachings in the specification, which expressly teaches the thickness from about 0.3 μ (300 nanometers) to about 100 μ (specification, paragraph 0031). Appropriate correction is required.

Specification

5. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph.

It is noted that in response to Examiner's objection to claim 28 in the prior Office action dated 6/10/2004, in which the Examiner stated that appropriate correction is required to the apparent erroneous thickness of the non-adhesive material form, and also pointed out that the instantly claimed thickness is not commensurate with the specification paragraph 0031, Applicant has amended the specification to include the apparently erroneous thickness recitation into the specification, and stated that the amendment is proper because claim 28 is an original claim.

With respect to Applicant's argument and amendment, the Examiner notes that while claim 28 is an original claim, its recited thickness of 30 nanometers appears to be too thin to be enabled for an effective non-adhesive material form. In particular, it is also noted that the original specification clearly leads one of ordinary skill in the art to a much thicker and narrower range (2μ to about 20μ , paragraph 0035). Additionally, the Examiner would like to point out that according to the periodic table, the diameter of carbon atom is 1.82 \AA (see article at <http://hyperphysics.phy-astr.gsu.edu/hbase/pertab/c.html#c1>), so a thickness of 30 nanometers (300 \AA) is only approximately equivalent to 182 carbons stacked in a straight line side-by-side. Since the non-adhesive material form is made from a curable ink of polymeric materials (paragraph 0017), which typically contain thousands of carbon atoms each polymer molecule, it appears to the Examiner that a thickness of 30 nanometers unreasonably

requires the thickness of a cured non-adhesive material form to be in the molecular thickness range or less. As such, in the absence of a proper evidentiary support for enablement, it is the Examiner's position that the amendment appears to be improper, and renders the specification unclear and not enabling as to how such a thin thickness is to be made and functions effectively. Finally, Applicant is required to provide an evidentiary support to show that a thin coating of only 30 nanometers is reasonably enabled for the intended use of the instant invention, or an appropriate correction is again requested.

Claim Rejections - 35 USC § 112

5. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the thickness of non-adhesive material forms having an average thickness of from about 0.3μ to about 100μ , or from 0.5μ to 50μ , or from about 2μ to about 20μ (see paragraph 0035), does not reasonably provide enablement for a thin coating of 0.03μ (30 micrometers). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with the extremely thin layer of non-adhesive material form.

In particular, the Examiner repeats that it appears that a thickness of 30 nanometers unreasonably requires the thickness of a cured non-adhesive material form to be in the molecular thickness range, as set forth above. As such, Applicant is required to provide a proper evidentiary support that an extremely thin coating of only

30 nanometers is reasonably enabled for the intended use of the instant invention, or an appropriate correction to the apparent typo is required.

6. Claims 27-29 and 32-52 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A pattern of non-adhesive material providing a path for air egress from adhesive article is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The Examiner repeats (see section 5 of prior Office action dated 6/10/2004) that it is noted that the instantly claimed invention is directed to "an adhesive article which provides air egress" (Abstract) by a non-adhesive material which is generally present in a pattern that provides a path for air egress from the adhesive article, such as when lines are used, at least about 50% of the pattern should extend to the edge of the adhesive article to obtain acceptable air egress (specification, paragraph 0031). However, the aforementioned essential elements are absent from the independent claim 27, and renders the claimed invention not enabled by the disclosure.

With respect to Applicants' argument "Applicant's disclosure provides at paragraph [0019] the following:

[0019] As discussed above, the present invention relates to adhesive articles such as those used for industrial graphics. The adhesive articles provides one or more of air egress, repositionability and slidability for easy application to a substrate.

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Air egress is only one of several different properties or advantages provided by the Applicant's claimed adhesive articles. Air egress is not critical or essential" (Remarks, page 7, 4th paragraph), the Examiner notes that the adhesive articles in paragraph [0019] of the specification are clearly directed to various distinct inventions. For example, the previously cancelled claims 53-95 are clearly directed to structurally distinct inventions for adhesive articles having repositionability and slidability, because the non-adhesive material forms in claims 53-95 are claimed to be flash or protruded (relative to the outer surface of the adhesive layer), which prevent/reduce contact between the adhesive surface and the substrate, and provides repositionability and slidability. In the contrary, the instant invention does not provide a means to prevent/reduce the contact between the adhesive surface and the substrate, and it appears to be directed for air egress application only. As such, the Examiner maintains that essential structural elements for air egress are absent from the independent claim 27, proper amendment is requested.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within


TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VSC
Victor S Chang
Examiner
Art Unit 1771


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